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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,568	05/02/2001	Frederik M. DeWolf	T7900-10	6323

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3693

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/740,568	Applicant(s) DEWOLF ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-5,7-9,13,14,17-19,21,22,24,25,27-29,31-33,35,37,38,42,43,46-48,50-52,54-61,64-71,74,76-79 and 81-89.

Continuation of Disposition of Claims: Claims rejected are 1-5,7-9,13,14,17-19,21,22,24,25,27-29,31-33,35,37,38,42,43,46-48,50-52,54-61,64-71,74,76-79 and 81-89.

DETAILED ACTION

1. This communication is in response to amendment filed 5/30/2006.

Formal Matters

The applicant has requested that the examiner confirms the file wrapper and PAIR to reflect the actual filing date of the application as 12-18-2000. The examiner suggests that the applicant contact OIPE **Initial Patent Examination**, Office of (OIPE) at 571 272-4000.

Claim Objections

The following claims are objected to because of minor informalities.

2. Claims 1 and dependent claims are objected to because it refers to limitation “an asset” in the body of the claim (see “assigning” step), which does co-relate to the same term referenced in the preamble. Appropriate correction is required.
3. Claim 21 “is is” should read “is”.

Claims 28-29, 31-33,35,37-38,42-43,46-48 are objected to because claim 28 refers to limitation “the data” which lacks positive antecedent basis. The examiner interprets this to read “the information”.

The following claims are objected to as improper dependent claims.

Claim 85 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Since the “computer readable memories is interpreted as an

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apparatus such as a CD-ROM or a diskette which contains the computer programs in question, such an apparatus would not infringe the method steps of claim 1 since the CD-ROM itself never performs any of the active steps of assigning, recording, categorizing, managing and providing required by the method. In other words mere possession of such a computer readable memory would infringe on claim 85, but this is not enough to infringe claim 1. As a result claim 85 is improper dependent claim.

Claim 87 is improper dependent claim upon claim 1, because claim 1 does not recite process of producing "dimensional or object database data structure".

Response to Amendment

4. Claims 1, 25, 27, 28, 29, 31-33, 35, 37-38, 42-43, 46-47, 50, 71 and 84-87 have been amended per request. Claims 1-5, 7-9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-52, 54-61, 64-71, 74, 76-79 and 81-89 are pending.
5. Upon further review of the amended claims in light of the **Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility**, the examiner has determined that certain pending claims are non-statutory under 35 USC 101 as failing to produce "useful, concrete and tangible result". This rejection has not been presented in the prior office actions. Accordingly, this office action is issued as a non-final action. Applicant's arguments concerning rejection of claims 71-74, 84 and 87 have been fully considered but are not persuasive. Refer to rejections of the claims under 35 USC §101.
6. The applicant's arguments with respect to prior art rejections have been fully considered and are persuasive. Accordingly, the examiner has withdrawn the prior art rejection of claims over Logan reference. Therefore, the only pending issues pending are 35 USC 101 and 35 USC 112 rejections as presented in the following sections.

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7. The applicant's arguments concerning 35 USC 112 (second) rejections of certain claims have been considered. However, it is noted that the amended claims contain certain deficiencies leading to new 35 USC 112 (second) rejections.

Claim Rejections - 35 USC § 101

8. Claims 1-5, 7-9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37-38, 42-43, 46, 48, 50-52, 54-61, 64-71, 74, 76-79 and 81-89 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In accordance with the revised Interim Guidelines for Subject Matter Eligibility (refer to web link,

http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html)

for details), a claimed invention must satisfy the requirement that it be directed to a "practical application" which is to mean "the claimed invention physically transforms an article or physical object to a different state or thing, or ... the claimed invention otherwise produces a useful, concrete, and tangible result".

Since, the physical transformation test is not relevant to the instant claims, the proper test to determine whether the claimed invention satisfies the "practical application" is whether the claimed invention produces a useful, concrete and tangible result. The focus is on the result of the claim as a whole, not the individual steps or structure used to produce the result.

A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable

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exception or it is merely likely that it would occur, it does not “flow inherently therefrom” and the claim would need to be amended to specifically recite the result.

Exemplary analysis of claim 1 is provided which applies to all independent claims, including the system/product claims 52, 55, 71, 85, 87 and 89.

Claim 1 recites a method for recording and managing information related to assets in an electronic asset registry. It is noted that the asset may be in the form of a digital object. The claimed invention assigns a unique identifier to the asset, records information related to the asset in an electronic asset registry and categorizes the information into multiple attributes. The claimed invention manages read and write privileges to the electronic asset registry for a plurality for entities and provides read and write access to asset attributes to the entities.

The claimed invention does not produce a tangible result. Managing read and write privileges to the asset registry for a plurality of entities and providing access to asset attributes to the entities for read and write capabilities does not produce a real world result because the claimed invention merely provides capabilities to the entities to read or write attributes of an asset registry which has a categorized information pertaining to the assets into the attributes. No tangible and real-world result is produced (such as allocation of assets) by the process steps of managing of the read and write privileges and/or providing access to asset attributes as claimed.

Therefore, it is concluded that the claimed invention is not meet the requirements of being “useful, concrete and tangible” and is directed to a non-statutory subject matter.

The following text is reproduced from the Guidelines for Examination of Patent Applications under 35 USC 101.

“However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”). In other words, the opposite meaning of “tangible” is “abstract.””.

The foregoing analysis applies to all system and apparatus claims and dependent claims.

9. Claims 52-61, 71-74 and 81-84 are additionally rejected as being nonfunctional or nonfunctional descriptive material.
10. Claim 52 recites a system for recording information related to an asset and providing access to the information to interested parties. The claim comprises limitations which, viewed in light of the specification are program codes (interfaces) and database (asset registry) or computer executable codes. However, the computer codes or database themselves are not functional until a computer or a processor is connected to the asset registry in association with the interfaces. Therefore, claims 52, 54, 79, 81-84 and 86 in

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the present form are treated as nonfunctional system, which cannot produce “useful, concrete and tangible result”.

11. Claims 55-61 are analyzed as per claim 52 and dependent claims.
12. Claims 71 and 74 are product claims directed to “an electronic asset record” resulting from method of claim 1. An electronic record is interpreted as nonfunctional descriptive material. The applicant states that the record is on computer readable media, and “it is clear that record is functional and can function with a computer to effect a practical result”. The examiner disagrees with this interpretation because, the electronic record, generated from a process of claim 1 is not computer executable code but mere collection of data which is nonfunctional descriptive material, which even if recorded on a computer readable medium remains nonfunctional (i.e. not capable of producing concrete, tangible and useful result). See MPEP § 2106 (IV)(B)(1). Claim 71 recites “allowing said processor to read write access privileges” which is treated as intended use of the asset record. Such limitation is not afforded any patentable weight. See MPEP 2111.04.
13. Claim 87 is directed to a data structure recorded on a computer readable medium. The data structure is interpreted as nonfunctional descriptive material. Further details are provided in claim 71 analyses.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

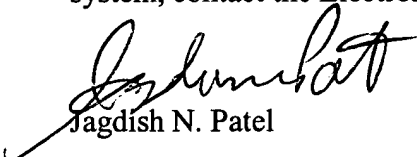
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

8/21/06